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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,007	07/09/2003	Johannes Willibrordus A. Overkamp	ACD2735US1	1024

7590 04/20/2004  
Richard P. Fennelly  
Akzo Nobel Inc.-Intellectual Property  
7 Livingstone Avenue  
Dobbs Ferry, NY 10522

EXAMINER

VOLLANO, JEAN F

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/616,007	OVERKAMP ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jean F. Vollano	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 (in part), and 12 (in part), drawn to a process for the preparation of a hydroxyperacid using  $R1[C(O)OC(O)OR2]_n$  or  $[R3C(O)OC(O)O]_p R4$ , classified in class 562, subclass various.
- II. Claims 1-9 ( in part ) , drawn to diacylperoxide using  $R1[C(O)OC(O)OR2]_n$  or  $[R3C(O)OC(O)O]_p R4$  classified in class 558, subclass various.
- III. Claim 10 -11 (in part), drawn to a process for the preparation of a mixed anhydride  $R1[C(O)OC(O)OR2]_n$ , classified in class 558, subclass various.
- IV. Claim 10-11 (in part), drawn to a process for the preparation of a mixed anhydride  $[R3C(O)OC(O)O]_p R4$ , classified in class 558, subclass various.
- V. Claim 12 drawn to a hydroxydiacylperoxide, ( product by process) 558 , various subclasses
- VI. Claim 13 and 16 (in part) drawn to the method of using a hydroperoxide for bleaching, , classified in class 568. 528, subclass various.
- VI. Claim 13 and 16 (in part), drawn to a method of using a hydroperoxide for oxidation, classified in class 564, 568, 562 etc, subclass various.
- VIII. Claim 13 and 16 (in part), drawn to a method of using a hydroperoxide for epoxidation, classified in class 549, subclass various.

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- IX. Claim 13 and 16 ( in part ) , drawn to a method of using a hydroperoxide for chain transfer, classified in class 568, subclass various.
- X. Claim 13 and 16 (in part), drawn to a method of using a hydroperoxide for copolymerizations or copolymer modification reactions, classified in class 526,528, subclass various.
- XI. Claim 14 , drawn to a method of using a hydroperoxide for the preparation of poly(methyl) acrylates, classified in class 526, 528 , subclass various.

It is noted that claims 13-14 and 16 are written improperly and if any of the claims is elected then the method of use claims should be written in the proper form giving the steps in the method claims.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XI are unrelated. Inventions are unrelated if it can be shown that they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and different effects. Group I is drawn to the preparation of peracid by the reaction of a mixed anhydride of formula  $R_1[C(O)OC(O)OR_2]_n$  or  $[R_3C(O)OC(O)O]_p R_4$ . This differs from Group II in that the product being prepared is diacylperoxide and not a peracid. The diacylperoxide are found in a different Class and subclass and the process of Group I is preparing a different compounds than Group II. A 35 USC 102 rejection of Group I would not obviate a rejection of Group II. The processes are patentably distinct. Group III and Group IV are processes for preparing different anhydrides of the two formulas given. The step of preparing the anhydrides is not a step in the process of the preparation of any of the compounds in Groups I or II. If applicant would like it to

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be a step then the process for preparing the peracid or the diacylperoxide should begin with first preparing the anhydride and then continuing. The mixed anhydrides being used in the reactions of Groups I-II are the same no matter what the preparation of the anhydride was. If the limitation of the process steps were to be part of the claim it would should be added to the independent claim as a first step or have all the steps place as addition steps in claim 10 but not as is written.

The method claims are improper because they are not in statutory form. The grouping of the method of use claims is showing what the Groups would be if written in statutory form. However again it is noted that the method of use of a compound that is a known compound is independent of the method of preparation. The known compound is the same no matter how it is prepared. The methods of use are all patentably distinct and would be classified by what is being prepared. The method of using a compound in oxidation is different than the method of using the same compound in copolymer modification reactions. The method of use as expoxidation reagent is different from an oxidation reagent. The methods of use are related to the compounds being prepared, respectively. There is product by process claims which are grouped into Group V. The product does not depend on the process and reads on any compound that fits the verbal structure.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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A telephone call was made to Mr. Richard P. Fennelly on 4/18/2004 to discuss the election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

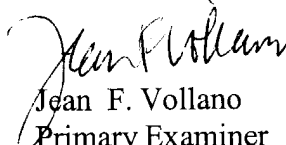
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 571-2720648. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272- 0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jean F. Vollano  
Primary Examiner  
Art Unit 1621

April 18, 2004